

James David Jacobs (JJ-7351)
Frank M. Gasparo (FG-2958)
Robert Busby
Todd S. Sharinn (TS-0581)
BAKER & MCKENZIE LLP
805 Third Avenue
New York, New York 10022
(212) 751-5700
Attorneys for Defendant Oberthur Card Systems, S.A.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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LEIGHTON TECHNOLOGIES LLC,)
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Plaintiff and Counterclaim Defendant,) 04 Civ. 02496 (CM)(LMS)
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OBERTHUR CARD SYSTEMS, S.A.,)
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Defendant and Counterclaim Plaintiff.)
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OBERTHUR CARD SYSTEMS, S.A.

**DEFENDANT OBERTHUR CARD SYSTEMS, S.A.' S STATEMENT
OF UNDISPUTED MATERIAL FACTS PURSUANT TO LOCAL
RULE 56.1**

Pursuant to Local Rule 56.1 of the United States District Court for the Southern District of New York, Defendant Oberthur Card Systems, S.A. (“Oberthur”) submits this Statement of Material Facts in support of its Motion for Summary Judgment:

1. Plaintiff Leighton Technologies LLC (“Plaintiff”) alleges that Oberthur infringes certain claims in four United States Letters Patents (the “Asserted Claims”), namely -- claims 1-8, 11, and 13-17 of U.S. Pat. No. 5,817,207 (“the ‘207 patent”); Claims 1-8, 11-16 of U.S. Pat. No. 6,214,155 (“the ‘155 patent”); claims 1-6, 8, 9, 12, and 14-16 of U.S. Pat. No. 6,036,099 (“the ‘099 patent”); and claims 1-5, 7-9, 12, 15-17, and 19-23 of U.S. Pat. No. 6,514,367 (“the ‘367 patent”)) (collectively the “Patents”). *See* Plaintiff’s Infringement Contentions.

2. The earliest effective filing date for the ‘207 patent is October 17, 1995.
See Sharinn Ex. 1.

3. The earliest effective filing date for the ‘155 patent is October 17, 1995.
See Sharinn Ex. 3.

4. The earliest effective filing date for the ‘099 patent is October 17, 1995.
See Sharinn Ex. 2.

5. The earliest effective filing date for the ‘367 patent is October 17, 1995.
See Sharinn Ex. 4.

6. The 1987 Oakwood Series 6 Laminators Brochure (“1987 Oakwood Series 6 Brochure”) was published at least prior to December 31, 1988. *See Smith ¶ 16.*

7. The 1987 Oakwood Series 6 Brochure is prior art under 35 U.S.C. § 102(b).

8. The 1987 Oakwood Sales brochure entitled “Lamination Presses for Bank Card & Printed Circuit Board Production” (“1987 Oakwood Sales Brochure”) was published at least prior to December 31, 1988. *See Smith ¶ 16.*

9. The 1987 Oakwood Sales Brochure is prior art under 35 U.S.C. § 102(b).

10. The 1991 Oakwood Series 6 Instruction Manual was published at least prior to December 31, 1992. *See Smith ¶ 13 and 17.*

11. The 1991 Oakwood Series 6 Instruction Manual is prior art under 35 U.S.C. § 102(b).

12. Japanese Patent Application Publication H6-176214 was published June 24, 1994. *See Sharinn Ex. 6 and Ex. 24.*

13. Japanese Patent Application Publication H6-176214 is prior art under 35 U.S.C. § 102(b).

14. U.S. Patent No. 4,450,024 was published June 24, 2005. *See* Sharinn Ex. 14.
15. U.S. Patent No. 4,450,024 is prior art under 35 U.S.C. § 102(b).
16. U.S. Patent No. 5,519,201 was filed on April 29, 1994. *See* Sharinn Ex. 13.
17. U.S. Patent No. 5,519,201 is prior art under 35 U.S.C. § 102(e).
18. U.S. Patent No. 4,897,533 was published January 30, 1990. *See* Sharinn Ex. 15.
19. U.S. Patent No. 4,897,533 is prior art under 35 U.S.C. § 102(b).
20. U.S. Patent No. 4,841,134 was published May 30, 1990. *See* Sharinn Ex. 16.
21. U.S. Patent No. 4,841,134 is prior art under 35 U.S.C. § 102(b).
22. U.K. Patent Application G.B. 2 225 283 A was published May 30, 1990. *See* Sharinn Ex. 20.
23. U.K. Patent Application G.B. 2 225 283 A is prior art under 35 U.S.C. § 102(b).

24. U.K. Patent No. 2 279 610 was published January 11, 1995. *See* 35 Sharinn Ex. 18.

25. U.K. Patent No. 2 279 610 is prior art under 35 U.S.C. § 102(a).

26. Each and every element of the Asserted Claims is present in at least one of the aforementioned prior art references, as shown in the Claim Chart annexed as Appendix A to the Memorandum In Support of Oberthur's Motion for Summary Judgment of Patent Invalidity ("Claim Chart").

27. At the time of the purported inventions of each of the Asserted Claims were made a person of ordinary skill in the art would have found it obvious to combine the prior art references to arrive at the combination claimed in the respective Asserted Claims as shown in the Claim Charts. *See* Smith ¶¶ 7 and 10, Mosteller, generally.

28. Each and every element in claim 20 of the '367 patent is, explicitly or inherently, present in the 1987 Oakwood Brochures, as shown in the Claim Chart. *See* Smith ¶¶ 19-26 and Mosteller ¶¶ 9-21.

29. Each and every element in claims 1, 6-7 and 14-16 of the '155 patent is, explicitly or inherently, present in the 1987 Oakwood Brochures, as shown in the Claim Chart. *See* Smith ¶¶ 19-26 and Mosteller ¶¶ 9-21.

30. At the time of the invention the level of ordinary skill in the art to which the subject matter of the Patents pertain would be persons who had a college degree, preferably one in material science, chemistry or mechanical engineering, and two years of practical experience or alternatively had four years of practical experience in laminated plastic card development.

Dated: New York, New York
October 18, 2005

BAKER & MCKENZIE LLP

/S/
By: James David Jacobs (JJ-7351)

Attorneys for Oberthur Card Systems, S.A.
805 Third Avenue
New York, New York 10022
(212) 751-5700

Of Counsel:
Frank M. Gasparo
Robert Busby
Todd S. Sharinn